

## REMARKS

Claims 1-20 are currently pending, with claims 1, 10, 14, 16 and 19 being the independent claims. Claims 1, 3-10, and 12-20 have been amended. Claims 1 and 11 have been cancelled. The amendments to claims 4-7, 9, 12 and 13 are to correct minor claim wording, and are cosmetic in nature. Reconsideration of the application, as amended, is respectfully requested.

Claims 8, 15 and 17-19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response to this rejection, Applicant has amended the claims in a manner that is believed to address each specific rejection.

Regarding the rejection of claims 17 and 18, Applicant requests the Examiner to note that claims 17 and 18 are dependent claims directed to a network element that implements the method of the independent claims 14 and 16, respectively. Therefore, claims 17 and 18 are definite. Reconsideration and withdrawal of the rejections are therefore respectfully requested.

In the January 13, 2006 Office Action, independent claims 1, 10, 14 and 19, and dependent claims 2, 11, 15, 17 and 20 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,650,632 (“*Volftsun*”), while dependent claims 3-9 and 12-13 were rejected under 35 U.S.C. §103(a) as unpatentable over *Volftsun*. Independent claim 16, and dependent claim 18 were rejected under 35 U.S.C. §103(a) as unpatentable over *Volftsun* in view of U.S. Patent No. 6,324,175 (“*Shiomoto*”). For the following reasons, it is respectfully submitted that all claims of the present application are patentable over the cited reference.

Independent claims 1, 10, 14, 16 and 19 have been amended to recite that the network layer is an IP protocol. Support for this amendment may be found, for example, at pg. 11, lines 18-33 of the originally filed specification. No new matter has been added.

*Volftsun* relates to a method for transmitting signaling messages over a virtual private network (VPN) that request features not supported by a public network that implements the VPN (see col. 2, lines 30-34). Such a feature is accomplished by the use of an auxiliary network along with a primary network.

The April 27, 2005 Office Action (pg. 2, ¶ 5) states:

Volftsun discloses telecommunication network transparency, which [is capable of communicating] voice and speech compression over Internet network, the system comprises first and second circuit (fig. 2), channel identifier (fig. 3). The system

encoding channel identifier in the forth octet of [its] IP address for [use] as a source destination IP address, i.e., the destination address of a network layer protocol datagram is determined from circuit switched channel identifying parameters and the network layer protocol address of the second network (Col. 12, Line 66-Col. 13, Line 22); specially, **in claim 2 recited IP address (see Col. 13, Line 8).** (Emphasis Added)

With respect to the foregoing statement, *Volftsun* fails to teach the method recited in amended independent method claims 1, 14 and 19. *Volftsun* (col. 12, line 66 to col. 13 line 3) teaches the performance of steps when a universal protocol “[Call]” message is received. *Volftsun* (col. 13, lines 3-5) states, “the originating auxiliary channel identifier is a value that indicates an address of protocol converter 150 in the auxiliary communication network 140”. *Volftsun* (col. 13, line 5-9) teaches that the originating auxiliary channel identifier can be the actual address of protocol converter 150 in the auxiliary communication network 140, such as a four-octet TCP/IP address commonly used in the Internet. Moreover, the IP in col. 13, line 8 of *Volftsun* suggests an embodiment that features a four octet TCP/IP for the network 140, i.e., a four octet Transmission Control Protocol/Internet Protocol. *Volftsun* thus teaches that the IP address of the originating auxiliary converter can be the TCP/IP address as commonly used in the Internet, and that this information is later transmitted in a message. However, such an address is the TCP/IP address of the originating converter.

In contrast, independent claims 1, 14 and 19 require the second node to possess the IP protocol address. *Volftsun* teaches that the message is sent through the primary network 130, i.e., the first node. Thus, *Volftsun* fails to teach or suggest that “an IP protocol from a first network node receiving data from a first circuit switched transmission line to a second network node transmitting data into a second circuit switched transmission line” is employed in a data transmission network or that “a destination address of an IP protocol datagram comprising data received from the first circuit switched transmission line for transmission to the second network node based on circuit switched channel identifying parameters which identify at least one channel in the second circuit switched transmission line and an IP protocol address of the second network node” is determined in accordance with a predefined rule, as recited in amended independent claim 1, 14 and 19.

It follows that *Volftsun* fails to teach or suggest the datagram recited in independent claims 1, 14 and 19. *Volftsun* (col. 13, lines 23-27) states, “at point 406, TCC 156 receives the

universal protocol [Call] message from UCM 154 and builds a connection request message in the protocol appropriate for the primary communication network 130 from relevant data in the call context 328”. *Volftsun* (col. 13, lines 28-34) further states, “TCC 156 appends a user-defined field to the connection request message that contains the call identifier, the originating auxiliary channel identifier, and the feature flag. Although the user field is generally too small to hold the whole feature string generated by the private network, the user field is typically large enough to hold this information”. Thus, *Volftsun* teaches the insertion of information into a user field. However, this message (i.e., the inserted information) is transferred through the primary communications system 130 of *Volftsun*, which is not an IP based system. Independent claims 1, 14 and 19 state that the datagram is an “IP protocol datagram” which is clearly IP based.

Furthermore, independent claim 19 recites the step of “inserting a number of data samples from said at least one channel of a transmission line into a payload portion of a data packet”. *Volftsun* (col. 1, lines 10-15) teaches reasons why corporations and other enterprises install private networks to interconnect their facilities to provide voice and data communications. *Volftsun* (col. 1, lines 50-55) describe a virtual public network (VPN). However, there is nothing here with respect to data samples. Thus, there is nothing in *Volftsun* with respect to a step associated with data sample insertion, as recited in amended independent method claim 19.

The January 13, 2006 Office Action (pg. 5, ¶ 5) states:

*Volftsun* did not explicitly state determining an **IP address** based on a time slot number having data which is transferred in the datagram. (Emphasis Added)

The above statement, in which the Examiner concedes *Volftsun* fails to teach IP addresses in the claimed manner, contradicts the Examiner’s statements in the prior April 27, 2005 Office Action. A complete review of the claimed subject matter reveals it is clear that *Volftsun* fails to teach the “IP protocol” as currently recited in amended independent claims 1, 14 and 19.

*Volftsun* (col. 13, lines 9-15) states, the originating auxiliary channel identifier indirectly indicates the auxiliary network address of protocol converter 150, for example, by a protocol converter unit identifier. *Volftsun* (col. 13, lines 15-22) states, each protocol converter in the network includes a translation table stored in storage device 208 that contains associations of a protocol converter unit identifier and the corresponding auxiliary network address for the so-identified protocol converter. After initializing the call identifier and the originating auxiliary channel identifier, UCM 154 send the universal protocol [Call] message to TCC 156.

*Volftsun* teaches the use of a specialized type of protocol. However, the claimed invention is not directed to a specific specialized, protocol. Rather, independent claim 1 includes features directed to circuit switched channel identifying parameters that identify at least one channel in the second circuit switched transmission line based on data received from the first circuit switched transmission line for transmission to the second network node based on circuit switched channel identifying parameters which identify at least one channel in the second circuit switched transmission line and an IP protocol address of the second network node. *Volftsun* fails to teach or suggest this aspect of the claimed invention. Consequently, amended independent claims 1, 14 and 19 are patentable over *Volftsun* and therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 and §103(a) are in order, and a notice to that effect is earnestly solicited.

The Examiner has cited *Shiomoto* to cure a deficiency of *Volftsun*, i.e., the failure to teach or suggest “determining an IP address based on a time slot number having data which is transferred in the datagram” recited in independent claim 16, as noted previously. *Shiomoto* relates to a circuit-switched network capable of providing synchronous transfer mode (STM) circuits dynamically (see col. 2, lines 22-24). *Shiomoto* (col. 2, lines 31-34) teaches that analysis of logical addresses in an STM network is performed, and that routing on a burst-by-burst basis on the basis of these logical addresses is also performed.

*Shiomoto* (col. 3, lines 50-56) states “a transit switch preferably comprises means for referring to the header of the burst data written in time slots and for reading its physical address, and means for relocating, in accordance with the read physical address or routing information, the burst data in time slots corresponding to this physical address”. However, *Shiomoto* fails to cure the deficiency of *Volftsun*, because there is nothing in *Shiomoto* with respect to the IP datagram recited in independent claim 16. Applicant therefore respectfully asserts that amended independent claim 16 is patentable over the combination of *Volftsun* and *Shiomoto* for at least this initial reason.

Moreover, concluding that it is proper to modify the system of *Volftsun* (i.e., primary communication network 130 and auxiliary communication network 140) based on the teachings associated with the network 20 of *Shiomoto* simply ignores the overall context of *Shiomoto*. In fact, only by referring to Applicant’s disclosure and engaging in an impermissible hindsight analysis would it be possible to arrive at the method recited in amended independent claim 16.

*Volftsun* (col. 4, line 66 thru col. 5, line 10) teaches that the primary communication network 130 is typically a public telephone network, along with its implementation of different signaling protocols. More particularly, *Volftsun* (col. 16, lines 50-52; Fig. 5) teaches a call flow diagram depicting steps taken by protocol converters 150 and 160 for terminating features presented during call establishment. *Volftsun* (col. 16, lines 52-56; Fig. 5) states, “in this scenario, those messages must be sent over the primary communication network 130 for connection and timing reasons and be sent over auxiliary communication network 140 to communicate the feature request. *Volftsun* (col. 16, lines 56-60; Fig. 5) thus teaches that messages must be sent twice, i.e. once over both the primary communication network 130 and the auxiliary communication network 140, but only one message must ultimately sent to an originating private network 100.

*Shiomoto* (col. 11, lines 32-38) teaches that burst data is transferred through an STM network, which enables an STM network to be operated more dynamically. *Volftsun* is directed to providing one communication path for connection and timing reasons and another communication path for communicating feature requests. In view of the foregoing, the combination of *Volftsun* and *Shiomoto* is improper, independent claim 16 is therefore patentable for at least this additional reason and thus, withdrawal of the rejection under 35 U.S.C. §103 are in order, and a notice to that effect is earnestly solicited.

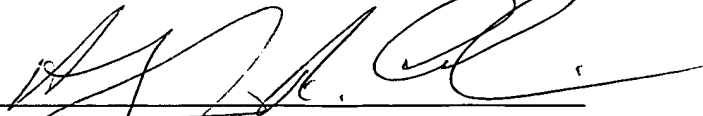
Independent claim 10 is a network claim associated with independent method claim 1. Accordingly, independent claim 10 is patentable over *Volftsun* and *Shiomoto*, individually or in the combination, for the reasons discussed above with respect to independent method claim 1.

In view of the patentability of independent claims 1, 10, 14, 16 and 19, for the reasons set forth above, dependent claims 3-9, 12, 13, 15, 17, 18 and 20 are all patentable over the cited prior art.

Based on the foregoing amendments and remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested.

Respectfully submitted,  
COHEN, PONTANI, LIEBERMAN & PAVANE LLP

By

A handwritten signature in black ink, appearing to read 'Alphonso A. Collins', is written over a horizontal line.

Alphonso A. Collins

Reg. No. 43,559

551 Fifth Avenue, Suite 1210

New York, New York 10176

(212) 687-2770

Dated: July 13, 2006